



UNITED STATES PATENT AND TRADEMARK OFFICE

K
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,351	02/21/2001	Takayuki Usui	Q61689	1061

7590 01/14/2003
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
Suite 800
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 01/14/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

AS8

Office Action Summary

Application No.

09/788,351

Applicant(s)

USUI ET AL.

Examiner

Walter B Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1772

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in the Abstract given on pages 3 and 14 of Applicant's Amendment (Paper # 6) have been received and considered by Examiner.
2. The amendments made in the Specification given on pages 1-2 and 13 of Applicant's Amendment (Paper # 6) have been received and considered by Examiner.
3. Amendments to original claims 1-18 were not made.
4. New claims 19-22 given on page 2 of Applicant's Amendment (Paper # 6) have been received and considered by Examiner.

Information Disclosure Statement

5. An initialed copy of the PTO-1449 form is enclosed as requested by Applicants on page 11 of Paper #6.

WITHDRAWN OBJECTIONS

6. The objection to the Abstract made of record in paragraph 1 of Paper #4 has been withdrawn due to Applicant's amendment in Paper #6.
7. The objection to the Specification made of record in paragraph 2 of Paper #4 has been withdrawn due to Applicant's amendment in Paper #6.

REPEATED REJECTIONS

8. The 35 U.S.C. 112 rejection of claims 1-18 is repeated for the reasons previously of record in Paper #4, page 3, section 4 in regard to the lack of structure of the packaging material and the packaging structure as discussed in the third and fourth paragraphs of section 4. The inconsistency between the specification and the claims addressed in the second paragraph of

Art Unit: 1772

section 4 has been addressed via amendment to the abstract and addition of new claims by the Applicants.

9. The 35 U.S.C. 102 rejection of claims 1, 2, 7-10 and 13-16 as anticipated by Hayashi et al. is repeated for the reasons previously of record in Paper #4, pages 4-5, section 6.

10. The 35 U.S.C. 103 rejection of claims 3, 5, 11 and 17 over Hayashi et al. in view of Usui (US 6,306,254) and in further view of Patent Abstract of Japan 03036545 of Goto et al. is repeated for the reasons previously of record in Paper #4, pages 5-7, section 8.

11. The 35 U.S.C. 103 rejection of claims 4, 6, 12 and 18 over Hayashi et al. in view of Dirx and in further view of Usui et al. (JP 8-39958) is repeated for the reasons previously of record in Paper #4, pages 7-9, section 9.

NEW REJECTIONS

12. Claims 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayashi et al.

Hayashi et al. teach a photothermographic sheet material composed of a support and a sensitive emulsion coated on the support (claim 1 and col. 4, line 45). A sheet of paper having smooth surfaces is inserted between every two sheets of the photothermographic sheet material (claim 1, col. 8) or the sheets of paper and sheets of the photothermographic sheet material are placed alternately (claim 10, col. 9). The paper has a Bekk smoothness of 5 to 10,000 seconds (col. 2, lines 48-54 and claim 2, col. 9). The sensitive emulsion layer and the paper are put in contact with each other in such a way that the paper is in intimate contact with the sensitive emulsion layer (col. 4, lines 55-67). Given that the sheet of paper has "smooth surfaces" (col. 2, lines 40 and 45-47 and claim 1), Examiner interprets the use of the plural form of "surface" to

Art Unit: 1772

indicate that both surfaces of the sheet of paper have a degree of smoothness as quantified by the stipulated Bekk smoothness range of 5-10,000.

In regard to the photothermographic sheet material taught by Hayashi et al., it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). The article of Hayashi et al. satisfies the claimed structural limitations of the planographic printing plate; the photothermographic sheet material taught by Hayashi et al. is structurally equivalent to the planographic printing plate as claimed in the instant application.

ANSWERS TO APPLICANTS ARGUMENTS

13. Applicant's arguments in Paper #6 regarding the 35 U.S.C. 112 rejection of claims 1, 2, 7 and 13 (Paper #4) have been fully considered but are not persuasive.

The claims should positively set forth the purpose of the "packaging material" and the "packaging structure" and the structure necessary for carrying out the purpose, i.e., the claim is incomplete in regard to the structure of the "packaging material" and the "packaging structure". No structure is claimed for the "packaging material" and the "packaging structure"; therefore, the scope of the claims cannot be ascertained thus rendering the claims indefinite. In response to Applicant's argument that "the claims are not indefinite; they are merely broad", Examiner agrees that the broadness of a claim does not make the claim indefinite: the claims are rejected as indefinite not because of the breadth of the scope of the claims but due to the fact that structure is not assigned to the "packaging material" and the "packaging structure". The claims are

Art Unit: 1772

indefinite due to the fact that the scope of the claims, and not the breadth of the scope of the claims, cannot be ascertained.

14. Applicant's arguments in Paper #6 regarding the 35 U.S.C. 102 rejection of claims 1, 2, 7-10 and 13-16 as anticipated by Hayashi et al. (Paper #4) have been fully considered but are not persuasive.

In regard to Applicant's argument that "the range of smoothnesses taught by Hayashi et al. is fundamentally different from the ranges of smoothness recited in the claims of the present invention" (item 1 under the Claim Rejections - 35 U.S.C. 102 heading on page 5), due to the fact that Hayashi et al. teach a photothermographic sheet material while the present invention is for planographic printing plates, it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987) as previously made of record in section 6 of Paper #4. The article of Hayashi et al. satisfies the claimed structural limitations (note the repeated 35 U.S.C. 112 rejection of the claims); the photothermographic sheet material taught by Hayashi et al. is structurally equivalent to the planographic printing plate as claimed in the instant application. Furthermore, the assertion that the range of smoothnesses taught by Hayashi et al. is "fundamentally different" than that of the instant application, is false, as Hayashi et al. teaches a Bekk smoothness range of 5-10,000 seconds, which completely encompasses the claimed smoothness ranges, save between 3 and 5 seconds. Note that the range of 8 to 100 seconds referred to in the last two lines of page 5, Paper #6 is not claimed in the instant application. The range of 250 to 900 seconds referred to in the last line of page 5, Paper #6 constitutes the majority of the 5 to 10,000 range taught by

Art Unit: 1772

Hayashi et al. and therefore, does not make a contribution over the teachings of Hayashi et al.

Also note that the range of 5 to 10,000 seconds is not only disclosed in the specification of Hayashi et al., but is also claimed by Hayashi et al. (col. 8, lines 41-42). Applicant's assertion that "Hayashi fails to recognize the importance of an upper limit in smoothness as it affects the separation of the paper from the printing plate" made in the first sentence of item 1 on page is better supported in item 2 on pages 6-9 and is addressed by Examiner in reference to Applicant's arguments made in item 2.

In regard to Applicant's argument that "Hayashi fails to disclose a value within Applicant's claimed range" (page 7, third paragraph) due to the teachings in the Examples where 360, 600 and 720 seconds are taught, Hayashi et al. still nonetheless teaches all the values in the range of 5 to 10,000 seconds by virtue of the fact that this range of 5 to 10,000 seconds is taught (N. B. and claimed). Applicant's claimed ranges of 3 to 55 seconds and 3 to 100 seconds as referred to by Applicant do indeed overlap with the range of 5 to 10,000 seconds taught by Hayashi et al.

In regard to Applicant's assertion that "Applicants have shown unexpected results for their narrow range" (page 7, fourth paragraph), the data presented in Tables 1 and 2 is not sufficient to support the assertion of the achievement of "unexpected results" in the form of "high separability from a non-imaging surface of a planographic printing plate" (last two lines of page 7) or in the form of "prevent[ion of] peeling of the film with more certainty" (page 8, first full paragraph).

In regard to separability, factors not related to smoothness would affect the separability of a given "packaging material", such as the material used as the packaging material, the thickness

Art Unit: 1772

of the packaging material, the particular automatic plate-making machine used, the presence or absence of a “coating film” on the material (a “coating film” is claimed in claims 1, 7 and 13, but not in claim 2) and the material used as the “coating film”. The specification itself reads that “by making the interleaf sheet 14 to have Bekk smoothness between 3 seconds and 55 seconds in the present embodiment, the interleaf sheet 14 can be separated from the non-imaging surface with certainty in an automatic plate-feeding mechanism” (paragraph bridging pages 17-18). The fact that “there is no such case” that the interleaf sheet of this particular embodiment “adheres to the non-imaging surface of the planographic printing plates” for Bekk smoothness values of 11-55 seconds (page 17, first full paragraph), whereas an interleaf sheet with a Bekk smoothness value of 65 “sometimes, adheres to and is not separated from the non-imaging surface” (page 16, second full paragraph) for the material in the present embodiment is by no means absolute evidence that that *any* “packaging material” of the structure taught by Hayashi et al. with a larger Bekk smoothness value would not perform suitably in an automatic plate-feeding mechanism. The claims do not limit the scope of the invention to the parameters of the aforementioned “present embodiment”.

Applicant’s assertion that “a Bekk smoothness from 3 to 100 seconds- for the surface that contacts the non-image side of the planographic sheet- is an important feature that produces unexpected results” (first full paragraph of page 8 of Paper #6 in reference to the data presented in Table 2 of the specification) in regard to the prevention of peeling of the film is not sufficiently justified, because the packaging material of Applicant does not produce unexpected results as film peeling does not occur for packaging materials of 3-100 or 250-900 seconds, results that would be expected from the teaching of Hayashi et al., as Hayashi et al. teach a

Art Unit: 1772

suitable range of from 5 to 10,000 seconds. Furthermore, the values tested between 100 and 250 seconds (i.e. 140 and 190 seconds), the specification discloses that “there *may* be slight film peeling *depending* on types of planographic printing plates 10 *but degree of the peeling is not so serious to cause practical problems*” (page 19, lines 20-22 of specification). Therefore, all values from 3-900 are suitable values for use, as would be fully expected from the teachings of Hayashi et al.

In regard to Applicant’s assertion that “one of ordinary skill in the art, following the teachings of Hayashi, would expect that smoothnesses well in excess of 55 seconds, or even 100 seconds, would not affect separability” (sentence bridging pages 8 and 9) and that “one of ordinary skill in the art would not readily envisage Applicants’ narrow range[s]” (second full paragraph page 9), the “upper limit” referred to is dependent on factors such as the material used as the packaging material, the thickness of the packaging material, the particular automatic plate-making machine used, the presence or absence of a “coating film” on the material and the material used as the “coating film” as discussed above. Hayashi teaches various types of materials used as the packaging material (col. 2, lines 39-47). Since the material is not specified in the claims of the instant application, the materials taught by Hayashi et al., by virtue of the fact that they are different materials, necessarily have “upper limits” that vary, but none of these materials have an “upper limit” greater than 10,000. The “upper limit” may be tailored via selection of the proper material (and suitable processing such as calendering treatment) taught by Hayashi et al. Applicants must claim a particular material or composition that is not taught by Hayashi et al. which yields an “upper limit” of 55 seconds in order to distinguish the instant application from the teachings of Hayashi.

Art Unit: 1772

Therefore, sufficient support does not exist for the assertion of the achievement of “unexpected results” and therefore, Applicants have not met the requirement that “there is evidence of unexpected results” as required by MPEP 2131.03 for *consideration* that “the narrow range is not disclosed with ‘sufficient specificity’ and is insufficient to establish anticipation” as relied upon in Applicant’s argument. Consequently, Hayashi does indeed disclose every element as set forth and arranged in the claims despite Applicants’ assertion to the contrary in the first full paragraph of page 6.

15. Applicant’s arguments in Paper #6 regarding the 35 U.S.C. 103 rejection of claims 3, 5, 11 and 17 over Hayashi et al. in view of Usui (US 6,306,254) and in further view of Patent Abstract of Japan 03036545 of Goto et al. (Paper #4) have been fully considered but are not persuasive.

In response to Applicant’s piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

The “planographic printing plate” recitation referred to on the bottom of page 9 has been treated in the answer to Applicants’ arguments to the 35 U.S.C. 102 rejection of claims 1, 2, 7-10 and 13-16 as anticipated by Hayashi et al. Hayashi et al. does indeed teach a packaging material having a Bekk smoothness of 3 to 100 seconds, also as discussed above. Accordingly, prima facie obviousness was indeed established in Paper #4.

16. Applicant’s arguments in Paper #6 regarding the 35 U.S.C. 103 rejection of claims 4, 6, 12 and 18 over Hayashi et al. in view of Dirx and in further view of Usui et al. (JP 8-39958) (Paper #4) have been fully considered but are not persuasive.

Art Unit: 1772

In response to Applicant's piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981).

The "planographic printing plate" recitation referred to on the bottom of page 10 has been treated in the answer to Applicants' arguments to the 35 U.S.C. 102 rejection of claims 1, 2, 7-10 and 13-16 as anticipated by Hayashi et al. Hayashi et al. does indeed teach a packaging material having a Bekk smoothness of 3 to 100 seconds, also as discussed above. Accordingly, prima facie obviousness was indeed established in Paper #4.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1772


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
01/03/03

WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

1/10/03